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10/802,858	03/18/2004	Tamotsu Sakuraba	09473.0002	7724

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EXAMINER

MCLEAN, NEIL R

ART UNIT	PAPER NUMBER
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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,858

Applicant(s)

SAKURABA ET AL.

Examiner

Neil R. McLean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/18/2004; 2/9/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 16-19, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/30/2008.

Note: Applicants elect to prosecute Species II. Claims 1-15 read on Species II. In a telephone conversation with the Examiner on January 24, 2008, the Examiner told Applicants' representative that he would examine claims 20, 22, and 23 if Applicants elected claims 1-15. Therefore, the Examiner has examined claims 20, 22, and 23 in addition to claims 1-15.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-15, 20, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Torigoe (US 2002/0018228).

Regarding Claim 1:

An image forming device (e.g., **FIG. 1 is a block diagram of an image processing system**), comprising:

a receiving unit for receiving a printing job (e.g., **CPU contained in Host 101 executes a program stored in Memory 103, or External memory 104, or supplied from an external apparatus as described in [0040]**);

a judging unit for judging whether an instruction for adding a specified mark to be printed in addition to image data is included in the printing job received by said receiving unit or not (e.g., **CPU 102 executes a program stored in the memory 103 to realize detection, judgment, color processing, quantization processing, and the like of a digital watermark or another mark for specifying a printing inhibition image as described in [0040].**);

a printing unit (e.g., **Printer 110 in Figure 1**) for printing the specified mark on a recording element including an IC tag (e.g., **The pattern may be an invisible digital watermark for embedding information in a specific frequency of an image, a visible digital watermark for embedding the information by a color invisible to human eyes (e.g., yellow dot), or any other digital watermark as described in [0040].**) when it is judged by said judgment unit that the instruction for adding the specified mark (e.g., **A mark detection unit 203 detects whether or not there is a specific mark or an image pattern for specifying the pre-registered printing inhibition image as described in [0042]**) is included in the printing job (e.g., **Judgment unit 204 determines whether or not the image to be printed is inhibited from being printed as described in [0042].**); and

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a writing unit for writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job (e.g., **A quantization unit 208 for the printer 110, a color processing and quantization of the image data are performed in a conventional known method, and the data is converted to data which can be printed by the printer 110 as described in [0042].)**

Regarding Claim 2:

An image forming device as claimed in claim 1, wherein

said writing unit writes on the IC tag included in the recording element IC tag information including the IC tag's managing number and the mark information indicating the specified mark's content (**Based on a drawing command outputted from an application 201, image information, for example, of respective 8 bits of RGB, that is, 24 bits rasterized in the image to be printed is stored in an image memory 202 in the printer driver as described in [0042].)**;

said image forming device further comprising an IC tag information transmitting unit for transmitting the IC tag information written on said IC tag by said writing unit to an external device that is capable of communicating with said image forming device (**The host 101 is connected to the printer 110 via the interface 106, and quantized image data is transmitted to the printer 110 which is then allowed to perform printing/recording as described in [0040].)**

Regarding Claim 3:

An image forming device as claimed in claim 2, wherein
said IC tag's managing number is assigned by said external device and received from said external device **(FIG. 2 is a block diagram showing an image processing by software executed by the program (printer driver) installed, for example, in the host computer, and outlines of periphery.)**

Regarding Claim 4:

An image forming device as claimed in claim 2, wherein
said IC tag information further includes information for specifying the image forming device used for writing the IC tag information **(Based on a drawing command outputted from an application 201, image information, for example, of respective 8 bits of RGB, that is, 24 bits rasterized in the image to be printed is stored in an image memory 202 in the printer driver as described in [0042].)**

Regarding Claim 5:

An image forming device as claimed in claim 3, wherein
said IC tag information further includes information for specifying the image forming device used for writing the IC tag information **(Based on a drawing command outputted from an application 201, image information, for example, of respective 8 bits of RGB, that is, 24 bits rasterized in the image to be printed is stored in an**

image memory 202 in the printer driver as described in [0042].)

Regarding Claim 6:

An image forming device as claimed in claim 1, wherein
said specified mark is a mark indicating that it is prohibited to copy a printed matter **(It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)**

Regarding Claim 7:

An image forming device as claimed in claim 2, wherein
said specified mark is a mark indicating that it is prohibited to copy a printed matter **(It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image**

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information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)

Regarding Claim 8:

An image forming device as claimed in claim 3, wherein said specified mark is a mark indicating that it is prohibited to copy a printed matter (It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)

Regarding Claim 9:

An image forming device as claimed in claim 4, wherein said specified mark is a mark indicating that it is prohibited to copy a printed matter (It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this

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mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)

Regarding Claim 10:

An image forming device as claimed in claim 5, wherein
said specified mark is a mark indicating that it is prohibited to copy a printed matter (It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)

Regarding Claim 11:

An image forming device as claimed in claim 1, wherein
said specified mark is a mark indicating that it is prohibited to take out a printed matter (It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose

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of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)

Regarding Claim 12:

An image forming device as claimed in claim 2, wherein
said specified mark is a mark indicating that it is prohibited to take out a printed matter (It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)

Regarding Claim 13:

An image forming device as claimed in claim 3, wherein

said specified mark is a mark indicating that it is prohibited to take out a printed matter **(It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)**

Regarding Claim 14:

An image forming device as claimed in claim 4, wherein
said specified mark is a mark indicating that it is prohibited to take out a printed matter **(It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)**

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Regarding 15:

An image forming device as claimed in claim 5, wherein said specified mark is a mark indicating that it is prohibited to take out a printed matter **(It is assumed that the watermark is used for a purpose preventing illicit counterfeit of paper money, stamp, securities, and the like, besides the purpose of protecting a copyright. For example, a special mark or a watermark is multiplexed beforehand in the paper money, stamp, securities, and the like, this mark is detected by an image output apparatus, information is regarded as image information of the paper money, stamp, securities, and the like, and a processing for discontinuing printing, issuing a warning, or intentionally coating the entire surface with black is performed as described in [0010].)**

Regarding Claim 20:

An image forming method comprising the steps of:

- 1) receiving a printing job;
- 2) judging whether an instruction for adding a specified mark to be printed in addition to image data is included in the printing job received in step i) or not;
- 3) printing the specified mark on a recording element including an IC tag when it is judged in step 2) that the instruction for adding the specified mark is included in the printing job; and
- 4) writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged in step 2) that the instruction

for adding the specified mark is included in the printing job.

Note: The Method Claim 20 is similarly rejected as Device Claim 1.

Regarding Claim 22:

An image forming program that causes a computer to execute a process comprising the steps of:

- 1) receiving a printing job;
- 2) judging whether an instruction for adding a specified mark to be printed in addition to image data is included in the printing job received in step 1) or not;
- 3) issuing an order for printing the specified mark on a recording element including an IC tag when it is judged in step 2) that the instruction for adding the specified mark is included in the printing job; and
- 4) issuing an order for writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged in step 2) that the instruction for adding the specified mark is included in the printing job.

Note: The Computer Executable Program Process of Claim 22 is similarly rejected as Device Claim 1 and Method Claim 20.

Regarding Claim 23:

A computer readable recording medium in which the image forming program as claimed in claim 22 is recorded **(A method of storing a program for operating the aforementioned embodiment constitution to realize the aforementioned embodiment function into a storage medium, reading the program stored in the storage medium as a code, and executing the present embodiment in a client computer and a server computer is included in categories of the aforementioned embodiments, and the storage medium in which the aforementioned program is stored is also included in the aforementioned embodiments as described in [0086].)**

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tomomatsu (US 7,058,214) discloses an image processing apparatus comprising, in order to judge an image prohibited by law from being printed at high speed, a judgment unit for judging for each predetermined area whether or not an output requested image includes information indicating that the image is a judgment object image; and a determination unit for determining the predetermined area for each predetermined distance with respect to the output requested image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is (571)270-

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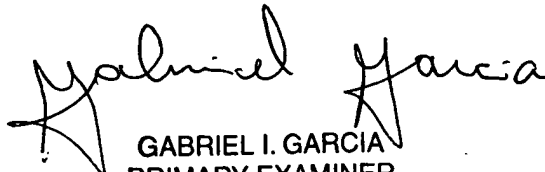
1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Neil R. McLean
03/03/2008



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PRIMARY EXAMINER